

Agilent Ref: 10021235-1
United States Application Serial No. 10/670,551

RESPONSE

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-8, 10, and 21-31, the only claims pending in this application.

Formal Matters

Claims 1-8, 10, and 21-31 are pending after entry of the amendments set forth herein.

Claims 1-8, 10 and 21-31 were examined. Claims 1-3 5-8, 28, and 31 were rejected and claims 4 and 10 were objected to. Claims 21-27, 29, and 30 were allowed.

Claims 1, 3, 28, and 31 have been amended. The amendment to the claim is made solely in the interest of expediting prosecution, and shall not be construed as an acquiescence to any objection or rejection. Support for the amendment to the claims is found in the claims as originally filed, and throughout the specification, in particular at the following exemplary locations: page 2, lines 8-12, page 5, lines 29-31, and as exemplified by Figure 3H.

As the above amendments introduce no new matter to the application, their entry is respectfully requested.

Allowable Subject Matter

The Applicants express gratitude in Examiner's indication that claims 21-27, 29 and 30 are allowed and that claims 4 and 10 are directed to allowable subject matter.

Rejection under 35 U.S.C. §112, second paragraph

Claims 3 and 28 have been rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. In particular, the Office Action objects to the use of a trademark in the claims. Claims 3 and 28 have been amended to replace the tradename Parylene ® with para-xylene. Accordingly, this rejection may be withdrawn.

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Rejection under 35 U.S.C. §102

Claims 1-3, and 5 have been rejected under 35 U.S.C. §102 for allegedly being anticipated by Li et al., (Nature, 412:166-169 (2001)). In view of the amendments to the claims and the remarks made herein this rejection is respectfully traversed.

The present invention is directed to a structure for the construction of one of a microscale and nanoscale device, comprising a rigid frame supporting a diaphragm **comprising a first material**, the diaphragm having an opening therethrough, and a **region of a second material** disposed in the opening and supported by the diaphragm, wherein the diaphragm is in tension.

In making the rejection, the Office Action equates the thin membrane observed in Li et al. as a by-product of the ion-beam sculpting of the Si₃N₄ support with the region of a second material of the claimed invention (Office Action, page 4, lines 5-7). However, the discussion of Figure 2C on page 167 further explains that the observed membrane is composed of Si and N (page 167, Figure 2 legend). Therefore, the membrane and the support are composed of the same material.

As such, in the spirit of expediting prosecution and without conceding as to the correctness of the rejection, claim 1 has been amended for clarification to further recite **"wherein the first material and the second material are different"**. Support for the amendment can be found in the claims as originally filed and throughout the specification, at for example, page 2, lines 8-12, page 5, lines 29-31, and Figure 3H.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). See also, Scripps Clinic and Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001 (Fed. Cir. 1991).

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Since Li et al. only teaches a structure comprising a single material, the cited reference fails to disclose every element found in the claims of the present invention. As such, claims 1-3, 5, 8, and 9 are not anticipated under 35 U.S.C. § 102 by the cited reference. Therefore, the Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 U.S.C. §103

Claims 6 and 7 have been rejected under 35 U.S.C. §103 for allegedly being rendered obvious by Li et al. In view of the amendments to the claims and the remarks made herein this rejection is respectfully traversed.

In order for a cited reference render the claims of the present application obvious, the reference must teach or suggest all the claim limitations (*In re Royka*, 180 USPQ 580 (CCPA 1974)). As noted above, the cited reference fails to teach each and every limitation found in the claims of the present application. In particular, the cited reference fails to teach a structure comprising a first material and a second material, **where the first material and the second material are different.**

As such, since Li et al. fails to teach each every limitation found in the claims of the present application, the cited reference fails to render the claims of the present application obvious. Therefore, the Applicants respectfully request that this rejection be withdrawn.

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CONCLUSION

The Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

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